

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 09

Filed by: Trial Section Merits Panel  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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MARK LIEBERMAN

Junior Party  
(Application 08/324,373)<sup>1</sup>,

v.

SHIGEKI INOUE, FUMIAKI TSUDA,  
MITSUO NAGAI,  
TADAMOTO SAKAI and KAZUYUKI NAKAMURA

Senior Party  
(Application 5,443,772)<sup>2</sup>.

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Patent Interference No. 104,362

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Before McKELVEY, Senior Administrative Patent Judge, SCHAFER  
and LEE, Administrative Patent Judges.

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<sup>1</sup> Filed October 17, 1994. The real party in interest is American Commodities, Inc. Accorded the benefit of application 08/103,298, filed August 9, 1993, now Patent No. 5,424,013, issued June 13, 1995.

<sup>2</sup> Based on application 08/087,321, filed July 8, 1993. The real party in interest is Japan Steel Works, Ltd.

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LEE, Administrative Patent Judge.

**JUDGMENT**

On August 31, 2000, senior party Inoue filed a paper (Paper No. 7) entitled "Senior Party Inoue's Notice of Intent Not to Contest the Interference," in which it is stated: "Senior party Inoue, Tsuda, Nagai, Sakai & Nakamura hereby advises that it does not intend to contest the interference as defined by count 1."

The submission is regarded as a concession of priority and/or abandonment of the contest with respect to the subject matter of the count. Under 37 CFR § 1.662(a), it is also treated as a request for entry of adverse judgment.

Junior party Lieberman has filed a response (Paper No. 8) in which Lieberman objects to an alleged inference in party Inoue's concession of priority that Inoue can contest the interference in some other way without filing a motion under 37 CFR § 1.633(c)(1) to substitute a different count. The response further states: "Inoue cannot reserve its 'right' to fight another day. The time to fight, if it is going to fight, is now."

Lieberman's response also states: "I am attaching a copy

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of a non-precedential opinion by SAPJ McKelvey in O'Young et al. v. Powers et al., Interference No. 104,592, which deals with a similar attempt to postpone the inevitable." No such copy, however, can be found accompanying the response.

We do not read party Inoue's notice of intent not to contest the interference as defined by count 1 as somehow reserving the right to fight for another day. We also do not read Inoue's notice of intent not to contest the interference as defined by count 1 as suggesting that Inoue will contest this interference in another way without moving to substitute a different count. Inoue's notice of intent not to contest the interference as defined by count 1 is a plain concession of priority or abandonment of the contest with respect to the subject matter of count 1 in this interference.

Inoue's request for entry of adverse judgment is granted.  
It is

**ORDERED** that judgment as to the subject matter of count 1 is herein awarded against senior party SHIGEKI INOUE, FUMIAKI TSUDA, MITSUO NAGAI, TADAMOTO SAKAI and KAZUYUKI NAKAMURA;

**FURTHER ORDERED** that Shigeki Inoue, Fumiaki Tsuda, Mitsuo Nagai, Tadamoto Sakai, and Kazuyuki Nakamura are not entitled

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to claims 1-6 of its involved Patent No. 5,443,772.

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Fred E. McKelvey, Senior )  
Administrative Patent Judge)

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Richard E. Schafer )  
Administrative Patent Judge)

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Jameson Lee )  
Administrative Patent Judge)

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BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES

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By Federal Express

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